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09/866,960	05/29/2001	Neil D. Scancarella	Rev 01-6	7403

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EXAMINER

OSTRUP, CLINTON T

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 07/16/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,960

Applicant(s)

SCANCARELLA ET AL.

Examiner

Clinton Ostrup

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-21 and 23-87 are pending in this application.

Response to Applicant's Declaration

The Declaration of Jean Manelski under 37 CFR 1.132 filed April 23, 2003 (Paper No. 14) is insufficient to overcome the rejection of claims 1-21 and 23-87 because while it compares the compositions in the Examples of McDermott to that of the instantly claimed compositions by replacing iron oxides with water soluble organic pigments and water insoluble organic pigments, placing pigments into various phases of the compositions to correspond with the pigment dispersed phases as claimed, removed waxes, and substituted the ammonium acrylates copolymer and added VS-70 or Polysilicone 6 and demonstrates the differences in smudge resistance, color transfer, and film integrity, the instant claims merely recite a "smudge resistant" composition. Since the declaration of Jean Manelski has shown the modified compositions of McDermott as having varying degrees of smudging, they must be "smudge resistant" to a certain extent. Smudge resistance is a relative term and without definite parameters as defined in the claims, thus, this term must be given its broadest reasonable interpretation and therefore, applicant has illustrated that the compositions, modified as suggested by the examiner, do have the "smudge resistant" properties, as claimed.

Therefore, the declaration is not convincing because the instant claims merely require the composition to be "smudge resistant" and the comparative analysis of Jean Manelski has shown the modified compositions of McDermott as having varying smudging properties.

Response to Applicant's Arguments/Amendment

Claim Rejections - 35 USC § 103(a)

Applicant's amendment and arguments filed April 23, 2003 (Paper No. 12), to the rejection of claims 1-17, 21, 26-33, 35-37, 41, 45-50, 52-54, 58, 62-68, 70-72, and 79-85 as being rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott, **US 6,248,336 B1**, have been fully considered and deemed persuasive, primarily because of the amendment to the independent claims wherein the film forming polymer has been further defined and the composition has been defined as being smudge resistant. Therefore, the said rejection has been withdrawn.

Applicant's amendment and arguments filed April 23, 2003 (Paper No. 12), to the rejection of claims 1-17, 21, 23-37, 41-54, 58-72, and 76-87 as being rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw, WO 00/47168 and further in view of McDermott, **US 6,248,336 B1**, have been fully considered and deemed persuasive, primarily because of the amendment to the independent claims wherein the film forming polymer has been further defined and the composition has been defined as being smudge resistant. Therefore, the said rejection has been withdrawn.

Applicant's amendment and arguments filed April 23, 2003 (Paper No. 12), to the rejection of claims 1-21 and 23-87 as being rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw, WO 00/47168 and McDermott, **US 6,248,336 B1**, and further in view of Calello et al., 5,849,275 have been fully considered; however, they have not been found convincing. Therefore, the said rejection has been MAINTAINED.

Applicant argues that the incorporation of the polymers limitations of claim 18 into claim 1, the incorporation of the polymers of claim 38 into claim 30, the incorporation of the polymers of claim 55 into claim 48, the incorporation of the polymers of claim 73 into claim 66, and amending claim 81 to further define the film forming polymer as it has been defined in amended claim 1 makes the instant claims patentable over the prior art because claims 18, because claims 18, 55, and 73 were not rejected over McDermott. However, claims 1-21 and 23-87 are rejected over the combination of references and Calello et al., was used for the teaching of the polymers of claims 18-20, 38-40, 55-57, and 73-75.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant further argues that even if the compositions of McDermott were modified, by removing inorganic pigments and substituting organic pigments, the resulting composition does not provide a commercially acceptable composition with smudge resistant properties. First "smudge resistance" is a relative term and the metes and bounds of what applicant regards as the invention are not clearly defined by "smudge resistant" because as shown by the declaration of Jean Manelski, the modified compositions of McDermott has varying degrees of "smudging." Moreover, the Composition C (Example 1 of McDermott) exhibits slight smudging, whereas

Composition T7 (McDermott formula of Example 1 without waxes and where the iron oxide pigments were dispersed in the oil phase) had definite smudging. Thus, Composition C was "smudge resistant as compared to Composition T7.

Applicant argues that Shah teaches an aqueous based composition containing acrylic acid or methacrylic acid polymer and water soluble organic pigments, but does not teach his claimed compositions in the water and oil emulsion form and the examiner has already appreciated the patentable significance of the difference between an emulsion and a solution by noting applicants comparative studies were not commensurate in scope with the claims.

First, as discussed above, this rejection is based on a combination of references and McDermott and Calello et al. teach water and oil emulsions. Secondly, applicants' previous comparative analysis, which was specifically done to show unexpected results, must be commensurate with what is being claimed. Finally, the statutory requirements for providing unexpected results are different from the requirement for determining the obviousness of an invention. Water and oil emulsions are known in the art, commonly practiced in the art, and McDermott was specifically used to demonstrate the obviousness of water and oil compositions.

Applicants' argue that the compositions of Calello et al., are different from the instantly claimed composition because the instantly claimed compositions are smudge resistant, whereas there is nothing in Calello et al., that talks about smudge resistance.

However, as discussed above, "smudge resistance" is a relative term and given its broadest interpretation, the comparative results, shown by Jean Manelski show the modified compositions as having various degrees of smudging.

Finally applicants argues that there is "nothing in the references alone or in combination teaches or suggests that any advantage would be derived from picking and choosing the specific items found in the references and combining them to arrive at the claimed compositions when considering the reference teachings. There is simply nothing in the four corners of the references themselves that suggests any advantage to so doing.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case Shah teaches long wearing cosmetic compositions for topical application to the skin that do not run or settle in the lines and creases of the skin. The reference teaches that the cosmetic compositions are particularly useful as eyeliners, or other eye or skin products. The reference teaches combining a acrylic acid or methacrylic acid derived polymer or copolymer and water soluble organic pigments to unexpectedly create a water resistant, long lasting film forming composition which can

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be applied to the skin. The primary reference teaches the specific organic pigments as claimed instantly and describes how it **may** be desirable to include small amounts of additional pigments such as inorganic pigments or combinations of organic and inorganic pigments. Therefore, the reference teaches compositions which may or may not contain inorganic pigments as color imparting ingredients in their invention.

McDermott describes how the make-up compositions of the present invention contain cosmetically acceptable pigments selected from the group of inorganic pigments, organic pigments, and pearlescent pigments and that the pigments are present in proportions depending on the color and the intensity of the color which it is intended to produce. This suggests that the skilled artisan can easily and readily choose any desired pigments, including organic pigments with or without inorganic pigments, based on the color desired. Moreover, the reference clearly identifies organic pigment commonly used in cosmetic compositions.

Calello et al., teach glossy transfer resistant cosmetic compositions which can be incorporated into water and oil emulsions comprising a polymer, a volatile solvent, a nonvolatile oil, a dry particulate matter, and water. The reference teaches that compositions comprising the polymer are long lasting, have a high gloss and shine and do not easily transfer to clothing or utensils.

Maintained Rejection

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claims 1-21 and 22-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah, WO 00/47168, and McDermott et al. 6,248,336, and further in view of Calello et al., 5,849,275.

Shah teaches long wearing cosmetic compositions for topical application to the skin that do not run or settle in the lines and creases of the skin. The Shaw reference teaches that the cosmetic compositions are particularly useful as eyeliners, or other eye or skin products. The Shaw reference teaches combining a acrylic acid or methacrylic acid derived polymer or copolymer and water soluble organic pigments to unexpectedly create a water resistant, long lasting film forming composition which can be applied to the skin. The Shaw reference teaches the specific organic pigments as claimed instantly and describes how it **may** be desirable to include small amounts of additional pigments such as inorganic pigments or combinations of organic and inorganic pigments. Therefore, the Shaw reference teaches compositions which may or may not contain inorganic pigments as color imparting ingredients in their invention. Furthermore, the Example of a Longwearing Cosmetic Composition on page 6 does not contain inorganic pigments. Moreover, the reference does not teach waxes or organic gelling agents in the composition, therefore, meeting the negative limitations of claim 86-87. Shah teaches that the compositions of the invention include any aqueous base that is miscible in water and can include glycerin and hydroalcohols, such as ethanol, propanol, and glycols, thus meeting the plasticizer limitation of instant claims 25, 42, 44, 61, and 78 as well as the volatile components of instant claims 16-17, 36-37, 53-54, 71-72, and 84-85. See: page 2, line 22 – page 6, line 35.

Although the Shaw reference teaches long lasting organic pigmented, film forming cosmetic compositions, which may further contain inorganic pigments, the Shaw reference lacks the specific water and oil emulsions as claimed instantly in claims

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1-21 and 23-87, the copolymers of instant claims 18-20, 38-40, 55-57, and 73-75, the surface coating of pigments as claimed in claims 33, and 50, and the pigments comprised in specific phases as claimed instantly in claims 3-4 and 30-85.

McDermott teaches cosmetic make-up compositions, particularly eye make-up compositions, such as mascaras, in the form of aqueous emulsions. The emulsions are taught to comprising insoluble polymeric material in an aqueous emulsion or latex and a lipophilic oil. These emulsions are then used to produce mascaras with improved wear and water resistance and are removable with soap and water. See: col. 1, lines 4-68 and abstract.

McDermott describes how polymeric emulsions containing plasticizers and solvents are well known in the art and that these compositions contain thickeners including water-soluble and water-swellaable polymers typically used in the art. See: col. 1, lines 26-40.

The McDermott reference describes how the compositions of their invention can be fabricated into a multitude of forms such as water-in-oil and oil-in water-emulsions to make creams and pastes. Thus meeting the limitations of instant claims 1-2, 30, 48, 66, 81, and 86. The McDermott reference teaches that the proportion of pigments used depends on the color and intensity of the color desired and that the pigments are selected from inorganic pigments, organic lake pigments, pearlescent pigments, and mixtures thereof. McDermott describes how the pigments may be surface-treated and teaches the specific inorganic and organic pigments of instant claims 5-8, 13, 31-33, 49-50, 67-68, and 82-83. See: col. 6, lines 1-45.

The McDermott reference teaches that optional ingredients such as silica, mica, talc, polymethacrylate, polyethylene, and thickeners such as water dispersible clays, which meet the specific limitations of instant claims 26-29, 45-47, 62-65, and 79-80. See: col. 6, line 45 – col. 7, line 10. McDermott exemplifies as an object of the invention to provide a mascara composition which comprises an alkyl or alkoxy-dimethicone copolyol as well as the insoluble polymeric material in an aqueous medium. See: col. 2, line 1 – col. 5, line 4.

McDermott teaches the use of polar oils and volatile oils, which meet the volatile components of instant claims 15-17, 36-37, 53-54, 71-72, and 84-85. However, McDermott lacks the teaching of the phases in which the emulsions contain the pigments and the pigment colors of instant claims 9-12, 14, 30, 48, 66, and 81.

Although the combined references above teach an emulsified organic pigmented composition, which may further contain inorganic pigments, the references lack the specific copolymers of instant claims 18-20, 38-40, 55-57, and 73-75.

Calello et al., teach Glossy transfer resistant cosmetic compositions which can be incorporated into water and oil emulsions comprising a polymer, a volatile solvent, a nonvolatile oil, a dry particulate matter, and water. The tertiary reference teaches the specific silicone acrylate copolymers of instant claims 20, 40, 57, and 75 as being the most preferred polymers. The reference teaches that compositions comprising the polymer are long lasting, have a high gloss and shine and do not easily transfer to clothing or utensils. See: col. 1, lines 45-68; col. 4, lines 22-26; col. 6, line 52 – col. 7, line 7; col. 8, lines 29-45; and abstract.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the modified the long wearing organic pigmented composition of Shah by forming a water and oil emulsion as taught by McDermott and adding the specific silicone acrylate copolymer of Calello et al. because of the reasonable expectation of obtaining an emulsified organic pigment containing composition that can have surface coated pigments, which could be added to any desired phase and could contain pigments of any desired color, with an improved long lasting adherence to the skin and having a high gloss and shine.

New Claim Rejection

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The term "smudge resistant" in claims 1-21 and 23-85, and 87 is a relative term which renders the claim indefinite. The term "smudge resistant" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The metes and bounds of what constitutes a "smudge resistant" composition, as claimed are not clearly defined.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clinton Ostrup whose telephone number is (703) 308-3627. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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Clinton Ostrup
Examiner
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July 14, 2003

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Clinton Ostrup